

**REMARKS/ARGUMENTS**

Claims 1-38 remain in this application. Claims 25-38 have been added.

**1. Rejections Under 35 U.S.C. §102**

**Applicable Standard**

For anticipation of an invention under 35 U.S.C. § 102, it is necessary that all the elements of an invention, as expressed in the patent claims, be found in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

**Claims 1-7, 14, and 17-24**

The Examiner has rejected claims 1-7, 14, and 17-24 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,234,389 to Valliani et al. ("the Valliani '389 patent").

The Examiner asserts that the Valliani '389 patent discloses

a portable transaction terminal (portable computing device 10) for processing POS transactions (see abstract), said terminal comprising a housing having a base, a top, and an enlarged head portion extending forwardly from the base to define a lip (note in figures 2-6 the different parts forming the device); a touch screen (340) disposed in said head portion comprising a display and touch sensitive overly [sic] (see col. 7, lines 30-38), said terminal (10) having a mode of operation in which said touch screen displays a virtual keyboard (note figure 7 the virtual pinpad or keyboard 370) for accommodation of data entry into side keypad. Valliani (fig. 3) shows an insert style reader unit (module 200) comprising at least one of a mag stripe (magnetic stripe reader 210) and smart card reader (230), wherein said reader unit is disposed in said lip, said reader unit having a feed slot (290) opening toward a front of said housing (col. 4, lines 4-61). (Paper No. 10, page 2, lines 8-18).

Applicants respectfully submit that the Valliani '389 patent does not teach each and every limitation recited by the claims. Pending claim 1 recites a portable desk top

transaction terminal for processing debit or credit card POS transactions, said terminal comprising: a housing having a base, a top, and *an enlarged head portion extending forwardly from said base to define a lip*; a touch screen disposed in said head portion comprising display and a touch sensitive overly, wherein said touch screen partially defines said housing top, said terminal having a mode of operation in which said touch screen displays a virtual keyboard for accommodation of data entry into side keypad; and an insert style reader unit comprising at least one of a mag stripe and smart card reader, wherein said reader unit is disposed in said lip, said reader unit having a feed slot opening toward a front of said housing. Applicants submit that in particular, the Valliani '389 patent does not teach the recited limitation of an enlarged head portion extending forwardly from the base to define a lip.

Applicants submit that for at least this reason claim 1 is patentable over the Valliani '389 patent. Applicants also submit, that for at least the reason that they depend from an allowable base claim, claims 2-7 are also patentable over the Valliani '389 patent.

With regard to claim 14, the Examiner asserts that the Valliani '389 patent

shows a transaction terminal comprising: a housing having a top, a front, a back end and a base having a base plane defined by a bottom of said base (note in figure 2-6 the different parts forming the device); a control circuit encapsulated by said housing (see figure 1, module 10); a touch screen (340) in communication with said control circuit at least partially defining a top of said housing (col. 4, lines 3-21), wherein said touch screen defines a touch screen plane (340) angled downwardly from said back end to said front with respect to said base plane (see fig. 6). Valliani discloses a card reader (220) in said housing having a an insert-style feed slot (290) for receiving a card (230), wherein said feed slot opens toward said front of said housing (col. 4, lines 4-61).

Claim 14 recites the limitation of "a touch screen in communication with said control circuit at least partially defining a top of said housing, wherein said touch screen defines a touch screen plane angled downwardly from said back end to said front with respect to said base plane". Applicants submit that the Valliani '389 patent does not teach this limitation. The Valliani '389 patent discloses *horizontal* touch screens and

therefore does not teach the angled touch screen recited by claim 14. Applicants submit that for at least this reason claim 14 is patentable over the Valliani '389 patent. Applicants also submit, that for at least the reason that they depend from an allowable base claim, claims 16-24 are also patentable over the Valliani '389 patent.

## 2. Rejections Under 35 U.S.C. §103

### Applicable Standard

Section 2143 of the Manual of Patent Examining Procedure ("MPEP") provides a succinct summary of the law governing obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 43.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

### Claims 8-13

The Examiner has rejected claims 8-13 and 15-16 under 35 U.S.C. §103(a) as being unpatentable over the Valliani '389 patent in view of U.S. Patent No. 4,902,079 to Kaplan et al. ("the Kaplan '079 patent").

The Examiner asserts that with regard to claim 8,

Valliani (fig. 1-6) shows a portable transaction terminal (portable computing device 10) for processing point-of-sale transactions (see abstract), said transaction terminal comprises a housing having a front, a top, and a base adapted for resting said terminal on a counter top, said base having a base plane defined by a bottom of said base (note in figures 2-6 the different parts forming the device); a touch screen (340) integrated in said top of said housing, said touch screen (340) being disposed in a touch screen plane (see col. 7, lines 30-38). Valliani (fig. 3) shows a hybrid mag stripe and smart card insert style reader (magnetic stripe reader 210) disposed in said housing (module 200), said reader unit having a

feed slot opening (290) toward said front of said housing, said feed slot disposed in a feed slot plane (col. 4, lines 4-61).

The Applicants agree with the Examiner's statement that the Valliani '389 patent does not teach all of the limitations recited by claim 8.

The Examiner asserts that the Kaplan '070 patent is in the same field of endeavor and that figure 1 of the Kaplan '079 patent shows "a desk mounted data collection terminal wherein the base, feed slot and touch screen plane are all substantially coplanar." Applicants submit that the Kaplan '079 patent does not teach a touch screen. The Kaplan '079 patent teaches a keyboard (14) or a graphics panel (14-1) and states that the "terminal may have a graphics panel 14-1 in place of the keyboard 14 if user keyboard entry is not required." (Col. 3, lines 24-26). Applicants respectfully submit that for at least the reason that the Kaplan '079 patent does not teach or fairly suggest a touch screen as asserted by the Examiner that the Kaplan '079 patent does not provide the suggestion or motivation to modify the teachings of the Valliani '389 patent to arrive at the claimed invention. Applicants respectfully submit that the Examiner is viewing the claimed invention with the benefit of hindsight and in doing so is imputing teachings to the cited references that are not present in those references.

Applicants respectfully submit that for these reasons the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 8 and request that the Examiner's rejection of claim 8 be withdrawn.

"[A] dependent claim, by nature, incorporates all the limitations of the claim to which it refers. *See 35 U.S.C. §112, ¶ 4 (1994).*" *Jeneric/Pentron, Inc. v. Dillon Company, Inc.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000). Claims 9-13 depend either directly or indirectly from claim 8. Therefore, claims 9-13 incorporate all of the limitations of claim 8. "Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). For at least the reason that they depend from an allowable base claim, claims 9-13 are allowable.

### **Claims 15 and 16**

“[A] dependent claim, by nature, incorporates all the limitations of the claim to which it refers. *See 35 U.S.C. §112, ¶ 4 (1994).*” *Jeneric/Pentron, Inc. v. Dillon Company, Inc.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000). Claim 15 depends from claim 14 and claim 16 depends from claim 15. Therefore, claims 15 and 16 incorporate all of the limitations of claim 14.

“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicants submit that for at least the reason that claims 15 and 16 depend from an allowable base claim, claims 15 and 16 are allowable over the art cited by the Examiner in the instant application.

All independent claims have been discussed. The dependent claims depend from, directly or indirectly, each independent claim discussed above and respectively recite each limitation therein. Accordingly, the dependent claims are allowable for the same reasons given above with respect to the independent claims. Applicants respectfully submit that all pending independent claims, and by extension, all of the pending dependent claims are in condition for allowance.

### **3. Conclusion**

Based upon the above remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests a timely Notice of Allowance be issued in this case.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.43.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-0289.

Please direct any questions or comments to Eric M. Smith at (607) 256-7330.

Respectfully submitted,

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